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| 09/846,225 | 05/02/2001 | David S. Gress | 95-460 | 7396 |
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| LEON R TURKEVICH 2000 M STREET NW 7TH FLOOR WASHINGTON, DC 200363307 | | | RAMOS FELICIANO, ELISEO | |
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| | | | 2687 | |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,225

Applicant(s)

GRESS ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3-5, 7-8, 12, 14, 16, 20, 22-24, 26-27, 31, 33-35, 37-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwelb et al. (US Patent Number 5,950,123), in view of Jones (US Patent Number 5,832,221) and further in view of Luther (US Patent Number 5,640,590).

Regarding **claims 1, 12, 20, and 31**, Schwelb et al., discloses a method in a server configured for executing messaging operations, the method comprising: receiving a short message service (SMS) that specifies text-based message, a messaging destination, and outputting the audible message for delivery to the messaging destination (column 6, lines 9-20). Schwelb does not disclose receiving a short message service (SMS) message that specifies a text-to speech messaging command. However, Jones teaches receiving a message that specifies a text-to speech messaging command (column 8, lines 51-59). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to modify Schwelb with the above teachings of Jones, so the sender has the option to tell server to convert to voice when sender knows the preferred format (as suggested by Jones, column 8, 51-55). Schwelb does not disclose detecting the text to speech messaging command during parsing of the SMS message; invoking a text-to speech resource for conversion of the text-based message into an audible

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message in response to detecting the text-speech messaging command. However, Luther discloses detecting the text to speech messaging command during parsing of the message; invoking a text-to speech resource for conversion of the text-based message into an audible message in response to detecting the text-speech messaging command (column 4, lines 24-30, and lines 51-54, see also blocks 302 and figure 3 and S318 in figure 3b). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to modify Schwelb with the above teachings of Luther, in order to avoid desynchronization as suggested by Luther (column 4, lines 24-30).

Regarding **claims 3, 22, and 33**, the combination of Schwelb, Jones, and Luther further discloses the detecting step includes detecting the text-to-speech messaging command as prescribed character within the SMS message (Luther - column 3, lines 43-53, and column 4, lines 23-29).

Regarding **claims 4, 23, and 34**, the combination of Schwelb, Jones, and Luther further discloses the detecting step further includes detecting the text-to-speech messaging command (Luther - column 4, lines 24-30) except for the text-to-speech command being adjacent to the messaging destination. Since applicant has not disclosed that this limitation solves any stated problem or is for any particular purpose, it would have been obvious to a person of ordinary skill in the art, to place the command next to the message destination, in order to allow the server to easily detect the text-to-speech command.

Regarding **claims 5, 14, 24, and 35**, the combination of Schwelb, Jones, and Luther further discloses the invoking step includes issuing a procedure call to the text-to-speech

resource, the text to speech resource executable within the server (Jones element 750 in figure 1, also see column 9, lines 54-61, and Luther- column 4, lines 23-30).

Regarding **claims 7, 26, and 37**, the combination of Schwelb, Jones, and Luther further discloses the outputting step includes outputting a notification message, including the audible message and specifying the message destination, to a notification resource configured for notifying the messaging destination with the audible message (Jones - column 8, lines 39-61).

Regarding **claims 8, 27, and 38**, the combination of Schwelb, Jones, and Luther further discloses the outputting step further includes generating the notification message including the audible message, the messaging destination, and a prescribed command specifying immediate notification the messaging destination (Jones - column 9, lines 42-53).

Regarding **claim 16**, see the rejection of *claims 7 and 8* as discussed above.

3. **Claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Schwelb et al., Jones, and Luther, as applied above, and further in view of Spielman et al. (US Patent Number 6,665,378).

Regarding **claims 9, 17, 28, and 39**, the combination of Schwelb, Jones, and Luther discloses the outputting step further includes outputting a notification message (Jones - column 9, lines 42-53). The combination of Schwelb, Jones, and Luther does not disclose notification message is according to SMTP protocol. However, Spielman discloses notification message is according to SMTP protocol (column 5, lines 21-32). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that the message notification can be sent using e-mail message (as suggested by Spielman, column 5, lines 25-29).

Regarding **claims 10, 18, 29, and 40**, the combination of Schwelb, Jones, Luther, and Spielman further discloses obtaining an e-mail destination for the notification message by accessing a subscriber profile directory based on the messaging destination and according to LDAP protocol. (Spielman - column 7, lines 40-51).

Regarding **claims 6, 11, 15, 19, 25, 30, 36, and 41**, the combination of Schwelb, Jones, and Luther discloses the outputting step (Jones - column 9, lines 42-53). The combination of Schwelb, Jones, and Luther does not disclose the outputting step includes: requesting a voice over IP resource to establish an audible connection with the messaging destination; and playing the audible message in response to establishment of the audible connection. However, Spielman discloses the outputting step includes: requesting a voice over IP resource to establish an audible connection with the messaging destination; and playing the audible message in response to establishment of the audible connection (column 5, lines 41-47). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that the voice over IP calls can be made (as suggested by Spielman, column 5, lines 41-47).

Regarding **claim 13**, the combination of Schwelb, Jones, Luther further discloses the interface is configured for receiving the SKIS message (Schwelb - column 6, lines 920). The combination of Schwelb, Jones, Luther does not disclose the interface is configured for receiving the SIVIS message according to SIVIPP protocol. However, Spielman discloses the interface is configured for receiving the SIVIS message (column 1, lines 50-57). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the

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combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that existing and established standards such as SMPP can be used for receiving SIVIS messages.

4. **Claims 2, 21, 32, and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Schwelb et al., Jones, and Luther, as applied above, and further in view of Ladd (US Patent Application Publication Number US-2003/0078989-A1).

Regarding **claims 2, 21, 32, and 42**, the combination of Schwelb et al., Jones, and Luther discloses everything claimed as applied above (see rejection of *claims 1, 12, 20, and 31*).

However, they fail to specifically disclose determining that the SMS message includes a destination number that corresponds to an SMS command processor within the server. Ladd discloses SMS messages (par. 0022). In a server, the message is processed by a text-to-speech processor (par. 0035). The message must contain text-to-speech processor's 56 address (claimed "destination number") in order to be properly routed from 12 to 56 and processed at 56 (Figure 4). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb et al., Jones, and Luther with the above teaching of Ladd, so that the SMS message includes a destination number that corresponds to an SMS command processor within the server, in order to be properly routed and processed.

Response to Arguments

5. Applicant's arguments filed September 16, 2004 have been fully considered but they are not persuasive.

6. Applicant argues via incorporation by reference the arguments presented April 2, 2004 (see page 1, third full paragraph of the present response).

In response these arguments have been treated in the Office action mailed June 16, 2004. Examiner's response to those arguments is clarified herein. Apparent omissions in consideration of certain previous arguments made by Applicant and distinctively pointed out in the present response are clarified herein.

7. Applicant argues, with reference to paragraph 9 of the Office action mailed June 16, 2004, that certain unclaimed features are inherent properties from the invention as described in the specification and submits as example that *enabling* and originator of the SMS message to request the claimed conversion is inherent from the claimed features (see page 2 of the present response).

In response it should be noted that previous arguments were more specific than this example. That is: (1) an originator of the SMS message can request conversion of the text-based message into an audible message, regardless of message type preferences for the messaging destination (p.13, lines 9-10 of the arguments presented April 2, 2004); (2) enabling the sender of the SMS message to request text-to-speech to be performed merely by sending the SMS message (as if automatic) (p.16, lines 12-13 the arguments presented April 2, 2004). For example, the argument concerning *regardless* of message type preferences for the messaging destination is not claimed nor considered an inherent property.

8. Applicant argues, with reference to paragraph 10 of the Office action mailed June 16, 2004, that the applied references have not been argued individually (see page 3, first two paragraphs of the present response).

In response it should be noted that the rejections are based on combination of references. Arguments presented April 2, 2004 against the references individually are self explanatory. Arguments presented in the present response are addressed herein.

9. Applicant argues, with reference to paragraph 11 of the Office action mailed June 16, 2004, that Luther is non-analogous art and that text-to-speech messaging is not within the field of the present invention's endeavor (see page 3, second full paragraph to page 4, first full paragraph of the present response).

In response it should be noted that it has been established (as indicated in the Office action mailed June 16, 2004) that the common field of Schwelb et al., Jones and Luther is text-to-speech messaging. In addition it should be noted that the present invention's field of endeavor is precisely text-to-speech messaging as shown by the title of the invention (converting SMS messages, i.e. text, to audible messages, i.e. speech) and the summary of the invention (pages 3-4, particularly page 4, line 7) of the present application.

10. Applicant argues that Luther has no relevance to the transfer of SMS messages (see page 3, second full paragraph to page 4, first full paragraph of the present response).

In response it should be noted that the rejection is based on a combination of references. Luther has not been applied for showing transfer of SMS messages, but for showing detecting the text-to-speech messaging command during parsing of the message and conversion to audible message in response to the detecting step. Schwelb et al. and Jones have met the rest of the limitations as explained in the rejection.

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11. Applicant argues a hypothetical combination of Schwelb et al., Jones and Luther described on pages 16-17 of the arguments presented April 2, 2004 (see page 4, last paragraph to page 5, first paragraph of the present response).

In response to applicant's argument that a hypothetical combination of Schwelb et al., Jones and Luther would provide no more than an SMS message that is converted to speech only if the destination subscriber attribute specifies the text-to-speech is to be performed, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

12. In response to applicant's argument that Luther provides an example of a multimedia scripting file that is stored in a memory and executed by a CPU for multimedia presentation and executing a script file (see page 5, second and third paragraphs of the present response), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In addition it should be noted that the rejection is based on a combination of references. Luther has not been applied for showing multimedia presentation or executing a script file, but for showing detecting the text-to-speech messaging command during parsing of the message and conversion to audible message in response to the detecting step. The combination of Schwelb et al., Jones and Luther have fully met the claimed limitations as explained in the rejection.

13. Applicant argues the Statement of Common Ownership with respect to Spielman et al. as described on page 18 of the arguments presented April 2, 2004 (see page 5, last paragraph to page 6, first full paragraph of the present response).

In response to subject statement of applicant's response presented April 2, 2004, it fails to overcome the rejection of claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41 in view of MPEP 706.02(I)(2)(II)(C) and the Guidelines To Implement Changes in 35 U.S.C. 103(c) published in the OFFICIAL GAZETTE of April 11, 2000 (1233 OG 55).

The Examiner respectfully notices that Spielman et al. (US Patent No. 6,665,378) does not show an assignment (normally indicated by "(73) Assignee:") as of the date of patent on December 16, 2003. In addition, as of February 3, 2004 the published U.S. patent contains a Certificate of Correction that is not directed to correct any deficiency in reference to assignments. The instant application was filed on May 2, 2001. Therefore, based on MPEP 706.02(I)(2)(II) the Examiner has independent evidence that raises a material doubt to the accuracy of applicant's representation of common ownership at the time the invention was made of the application being examined and the applied U.S. patent. Consequently, according to MPEP 706.02(I)(2)(II)(C) applicant needs to provide in addition to the above-mentioned statement regarding common ownership further objective evidence, including an explanation why the declarant believes there is common ownership. The OFFICIAL GAZETTE (1233 OG 55) section (II)(B)(2)(c) provides additional support for this fact.

14. Applicant argues Ladd with respect to an apparent improper inherency statement (see page 6, last two paragraphs of the present response).

In response the rejection has been clarified above. What is inherent is that fact that the disclosed text-to-speech processor's 56 contains and address that reads as the claimed destination number. From Figure 4, the message is routed from 12 to 56 to be processed at 56. The message must contain text-to-speech processor's 56 address (claimed "destination number") in order to be properly routed from 12 to 56 and processed therein.

15. In response to applicant's argument that Ladd teaches using the caller ID telephone number of the user's PCS digital phone number (see page 7, all paragraphs of the present response), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

16. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 6/10/05
ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf
June 10, 2005